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| EXAMINER |
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ROSSI, JESSICA

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| ART UNIT | PAPER NUMBER |
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1733

DATE MAILED: 04/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,242

Applicant(s)

ST. JOHN, CALI

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/24/03; Amendment C.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 3/24/03. Claims 1-17 are pending.
2. The rejection of claims 1-3, 4-7, and 11-17 based on the doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 10-13, and 18-23 of copending Application 09/951,723 in view of Ruemer (of record), as set forth in paragraph 12 of the previous office action, has been withdrawn because the copending application was abandoned.
3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 16-17 were amended to include the limitation "highly" to modify the word "flexible", which was already present in the claims; however, there is no support in the present specification for "highly."

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "highly" in claims 1 and 16-17 is a relative term that renders the claim indefinite. The term "highly" is not defined by the claim, the **specification does not use this**

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term and therefore does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicants use the word “flexible” in the specification to describe the protective members. One reading the claims in light of the specification would understand what Applicants mean by this term based on the language provided in lines 16-17 of p. 10. However, Applicants **never** describe the protective members as being “highly flexible” making it difficult for the skilled artisan to understand what is now being claimed when the claims are read in light of the specification. Therefore, a person of ordinary skill in the art could not interpret the metes and bounds of the claims so as to understand how to avoid infringement.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-2, 4-5, 12, and 14-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer (of record) in view of Granofsky (of record) and the collective teachings of Blotky (of record) and Bozlee (of record), or alternatively, Granofsky in view of Ruemer and the collective teachings cited above as set forth in paragraph 7 of the previous office action.

With respect to claims 1-2, Ruemer, directed to a protective member 10 for a beverage container, teaches manufacturing a consumer removed, flexible and collectable protective member and attaching promotional indicia (Figure 6) to the protective member (column 2, lines 49-58; column 5, lines 40-52). The reference is silent as to conveying by profit making sale a

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right to attach the indicia to the protective member and adhering the protective members to the container

It is known in the art to display advertising/promotional information on beverage and food containers wherein this information can be related to other products made by the company selling the container, or alternatively, **the information can concern an unrelated product (product sold by another company)**, as taught by Blotky et al. (column 1, lines 6-7; column 2, line 23; column 4, lines 1-2 and 12-18). Furthermore, it is known to engage in a **method of doing business** wherein the producer of a product gives a third party the right to advertise its products or services on the producer's product by selling these rights to the third party to **generate revenue/profit**, as taught by Bozlee (Figure 2; column 3, lines 1-5 and 22-26 and 36-38). It is noted that the producer's decision to pocket this money or use it to offset costs of production and/or marketing does not change the fact that this money is money the producer would not have had had he not done business with the third party – hence, this money is a “profit.”

It would have been obvious to one of ordinary skill in the art at the time the invention was made to conduct a business method by conveying by profit making sale the right to attach the indicia to the protective members of Ruemer by selling the right to third parties because such is known, as taught by the collective teachings of Blotky and Bozlee, wherein this practice is a source of revenue/profit for the inventors that can offset the cost of the invention.

Ruemer teaches attaching the peripheral edge 14 of the protective member to the container by means of a flanging operation (Figure 4; column 3, lines 37-39) where the protective member includes a retractable tab portion (column 2, lines 36-39). It is known in the

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art to attach a flexible protective member 10, which includes a retractable tab portion, to a container 11 using an adhesive, as taught by Granofsky (Figures 4-5; column 1, lines 5-9 and 20-22; column 2, lines 15-26 and 50-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use adhesive in addition to or as an alternative to the flanging operation to attach the protective member of Ruemer to the container because such is known in the art, as taught by Granofsky, where this would ensure that the protective member and container do not become disassembled during shipping or handling.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach promotional indicia to the **highly flexible** protective members of Granofsky (Figure 4) because such is known in the art, as taught by Ruemer, and this provides the inventors with a marketing tool that peaks consumer curiosity which increases the chances of the consumer purchasing the product.

It is noted that Granofsky teaches that the protective member does not completely separate from the container so that littering is avoided (column 3, lines 28-30); however, Ruemer also teaches that the protective member can stay attached to the container to avoid litter (column 2, lines 56-58) but can be removed to redeem a prize if the promotional indicia indicates that a prize has been won (column 2, lines 54-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the protective member of Granofsky capable of being completely separated from the container while also being capable of remaining attached to the container because such is known in the art, as taught by Ruemer, and this allows for prize redemption or litter avoidance depending on whether or not a prize is won.

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Regarding claim 4, Ruemer is silent as to sanitizing the mouth contact portion of the container. It would have been obvious to do so because such is known in the art, as taught by Granofsky (column 3, lines 1-5), where this ensures a clean contact portion for the user upon removal of the protective member.

Regarding claim 5, Ruemer teaches the indicia being for promotional and redeemable purposes (column 2, lines 49-51).

Regarding claim 12, Granofsky teaches adhering the protective members to the containers using adhesive (column 2, lines 50-52).

Regarding claim 14, Ruemer is silent as to treating the protective members with an anti-static chemical. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective members with an anti-static chemical to ensure that the members separate easily so as to not impede the manufacturing process.

Regarding claim 15, Ruemer is silent as to treating the adhesive so that it bonds more strongly to the member and less strongly to the can. It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the adhesive so that it bonds more strongly to the member and less strongly to the can so that the member can be easily removed by the consumer without the adhesive separating from the member and remaining on the can resulting in an unsanitized mouth contact portion.

8. Claims 3 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Granofsky, Ruemer, and the collective teachings of Blotky and Bozlee as applied to claim 1 above, and further in view of Cummings (of record) as set forth in paragraph 8 of the previous office action.

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Regarding claim 3, selection of a particular shape for the protective member of Granofsky would have been within purview of the skilled artisan. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an hourglass shape because it is known in the art to adhesively attach a highly flexible protective member to the opening of a liquid container where the protective member has an hourglass shape, includes a tab portion, has indicia printed thereon, and is **folded over the rim of the container when adherence occurs**, as taught by Cummings (Figure 3; column 3, lines 25-30 and 45-47 and 64-66; column 4, lines 32-39). It is noted that the present invention teaches wrinkling and deflation of the protective member being prevented by its having an hourglass shape (p. 10, lines 4-7). Since Cummings also teaches an hourglass shape, the skilled artisan would have appreciated that it too would prevent wrinkling and deflation.

Regarding claim 16, it is noted that this claim is a combination restating all the limitations in claims 1 and 3.

9. Claims 6, 9-11, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer, Granofsky (or Granofsky, Ruemer), and the collective teachings of Blotky and Bozlee as applied to claim 1 above, and further in view of Bjornsen (of record) as set forth in paragraph 9 of the previous office action.

Regarding claim 6, Ruemer is silent as to printing the indicia. It would have been obvious to one of ordinary skill in the art at the time the invention was made to print the indicia on the protective member of Ruemer because such is known in the art, as taught by Bjornsen (column 3, lines 29-31), where only the expected results would have been achieved.

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Regarding claim 9, Ruemer teaches the indicia being applied to the underside of the protective member (column 2, lines 45-49).

Regarding claim 10, Ruemer is silent as to the protective member being opaque. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an opaque protective member because such is known in the art, as taught by Bjornsen (column 3, lines 35-38), where only the expected results of preventing the user from seeing the indicia printed on the underside would have been achieved.

Regarding claim 11, Ruemer teaches the indicia being for promotional and redeemable purposes (column 2, lines 49-51).

Regarding claim 17, it is noted that this claim is a combination restating all the limitations in claims 1 and 9-11.

10. Claims 7-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer, Granofsky (or Granofsky, Ruemer), the collective teachings of Blotky and Bozlee, and Bjornsen as applied to claim 6 above, and further in view of Burns (of record) as set forth in paragraph 10 of the previous office action.

Regarding claim 7, Ruemer and Granofsky are silent as to treating the protective member to accept and retain printing ink. Treatment of the protective member would depend on the type of material used for the member, which would dictate its ability to retain printing ink. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the protective member of Ruemer or Granofsky because it is known to treat plastic closure members for beverage containers to prepare their surface for retaining printed matter, as taught by Burns (column 5, lines 46-65).

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Regarding claim 8, Burns teaches the treatment being by corona discharge (column 5, lines 61-63).

11. Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Ruemer and Granofsky (or Granofsky, Ruemer), and the collective teachings of Blotky and Bozlee as applied to claim 1 above, and further in view of Takayama (of record) as set forth in paragraph 11 of the previous office action.

Regarding claim 13, Granofsky is silent as to the adhesive being antibacterial. It would have been obvious to use an antibacterial adhesive because such is known in the art, as taught by Takayama (column 3, lines 12-16), and would prevent any contaminants from coming into contact with the consumer's mouth.

Response to Arguments

12. Applicant's arguments filed 3/24/03 have been fully considered but they are not persuasive.

13. On pages 1-2 of the arguments, Applicants argue that Ruemer does not teach the protective member being highly flexible.

Applicants are directed to the 112 1st and 2nd paragraph rejections set forth above. It is also noted that Granofsky does teach a highly flexible protective member (see paragraph 7 above).

14. On page 2 of the arguments Applicants argue that "revenue producing" and "profit making" are not the same thing. Applicants argue that because the producers in the prior art of record use the money gained from doing business with a third party for offsetting the costs of production and/or marketing, they are not profiting.

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The examiner respectfully points out that whether the producer decides to pocket that money or put it back into the business itself, this does not change the fact that the producer profited from doing business with the third party (producer still ends up with money he would not have had had he not done business with the third party; what he does with that money is irrelevant).

15. On page 2 of the arguments, Applicants argue that Blotky and Bozlee are not business method patents and both fail to teach the profit-making motive that accompanies a business method.

While the examiner agrees that neither Blotky nor Bozlee **claim** a method for doing business, this does not exclude the references as prior art against a claim that does - especially when the references **disclose** a method for doing business that results in profit-making.

16. On page 2 of the arguments, Applicants argue that neither Blotky nor Bozlee teach protective members on beverage cans.

The examiner does not dispute this fact. However, it is respectfully pointed out that Blotky is directed to the concept of a producer giving a third party the right to advertise its products on the producer's beverage cans. Although the reference does not explicitly state that the third party pays the producer to do so, the skilled artisan would readily appreciate that NO producer in its right mind trying to survive in a capitalist economy would allow a competitor to advertise its competing products on that of the producer's free of charge!

Although Bozlee is not directed to beverage containers, it is respectfully pointed out that this reference was only used to show that the concept of **selling** this right to third parties is known. Therefore, given that it is known in the beverage container art to put

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promotional/advertising material on protective members and given that it is known in the beverage container art for a producer to give a third party the right to place its promotional/advertising material on the producer's products, one skilled in the art would be extremely motivated to charge the third party a fee for this right when taken with the teaching of Bozlee.

17. On page 3 of the arguments, Applicants argue that Cummings fails to teach the hourglass shape of the protective member facilitating adherence to the container without wrinkling or defamation.

The examiner respectfully points out that the present specification teaches wrinkling and defamation being prevented by the protective member having an hourglass shape (p. 10, lines 4-7). Since Cummings also teaches an hourglass shape, the skilled artisan would have appreciated that wrinkling and defamation would be prevented.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733



jl
April 21, 2003



Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700